Remarks

In the present response, claim 5 is amended. Claims 1-21 are presented for examination.

I. Claims Rejection: 35 USC § 112

Claims 1 and 19 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description. The Examiner argues that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled that applicants had possession of the invention at the time the application was filed. These rejections are traversed.

The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession,* as of the filing date of application relied upon, of the specific subject matter later claimed by him (example, see *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

> [A]ll that is required is that it [the applicant] reasonably conveyed to
> persons skilled in the art that, as of the filing date thereof, the inventor
> had *possession* of the subject matter later claimed by him (see
> *Eiselstein*, 52 F.3d at 1039, 34 USPQ2d 1467, 1470).

In the present case, Applicants clearly had possession of the subject matter of claims 1 and 19. By way of example, FIG. 1 in Applicants' specification shows four storage cells 19. Each storage cell has two perturbations 18 and represents only a single data bit. Paragraph [0017] supports the recitations in claims 1 and 19:

> The presence of a dent represents a logical "1," while the absence
> of a dent represents logical "0." During write operations, use of the

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multiple tips 14 and 16 causes two redundant dents 18 to be created for each given storage cell 19. In the example of Fig. 1, four storage cells 19 are illustrated, with each storage cell 19 including a pair of redundant dents 18. Note that if dents are not formed in a given storage cell 19, then that represents a logical "0." Alternatively, if two dents are formed in a given storage cell, then the cell represents a logical "1." (See Applicants' specification at paragraph [0017]).

Based on the original figures and supporting language in the specification, Applicants clearly had possession of the claimed subject matter of claims 1 and 19.

II. Claims Rejection: 35 USC § 112

Claim 5 is rejected under 35 USC § 112, second paragraph, as lacking antecedent basis for the term "the redundant perturbations" in line 5. Claim 5 is amended to cure this error.

III. Claims Rejection: 35 USC § 102(a)

Claims 1, 3-8, 10-11, 14-17, and 19-21 are rejected under 35 USC § 102(a) as being anticipated by USPN 6,507,552 (Gibson). These rejections are traversed.

The claims recite numerous recitations that are not taught or even suggested in Gibson. Some examples are provided below for the independent claims.

As one example, claim 1 recites a probe having plural tips. Gibson does not teach or suggest a probe with plural tips. The Examiner argues that Gibson teaches this claim element in Fig. 4b at numbers 225 and 230. Applicants respectfully disagree.

Element 225 in FIG. 4b of Gibson is a tip of probe 215. Element 230, however, is not a tip, but a contacting sheath that extends around the tip to increase the lifespan of the tip (see Gibson at col. 9, lines 40-53). In other words, Gibson teaches a probe with a single tip, not plural tips.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227

U.S.P.Q. 773 (Fed. Cir. 1985)). For at least these reasons, claim 1 and its dependent claims are allowable over Gibson.

As another example, claim 1 recites a storage medium with each cell sized to represent only a single data bit. The claim then recites a probe that forms plural perturbations in at least one storage cell for representing only a single data bit. Gibson does not teach or suggest this element.

Gibson repeatedly shows in the figures that storage cells use a single perturbation. Nowhere does Gibson show or even suggest plural perturbations in at least one storage cell for representing only a single data bit. Where is the at least one storage cell having plural perturbations? In other words, the Examiner must identify one storage cell in Gibson having plural perturbations. Gibson does not teach or suggest such a storage cell. The storage cells in Gibson have a single perturbation.

For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference (see *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990)). For at least these reasons, claim 1 and its dependent claims are allowable over Gibson.

As one example, claim 14 recites a probe having plural tips. As noted in connection with claim 1, Gibson expressly teaches a probe with a single tip.

For at least these reasons, claim 14 and its dependent claims are allowable over Gibson.

As another example, claim 14 recites that the probe forms at least two perturbations in the surface in at least one of the storage cells for representing only a single data bit. As noted in connection with claim 1, Gibson expressly teaches forming a single perturbation in a storage cell to represent a data bit.

For at least these reasons, claim 14 and its dependent claims are allowable over Gibson.

As one example, claim 19 recites a probe having plural tips. As noted in connection with claim 1, Gibson expressly teaches a probe with a single tip.

For at least these reasons, claim 19 and its dependent claims are allowable over Gibson.

As another example, claim 19 recites forming at least two perturbations in the surface in at least one of the storage cells for representing only a single data bit. As noted in connection with claim 1, Gibson expressly teaches forming a single perturbation in a storage cell to represent a data bit.

For at least these reasons, claim 19 and its dependent claims are allowable over Gibson.

IV. Claims Rejection: 35 USC § 103(a)

Claims 2, 9, 12, and 18 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,507,552 (Gibson) in view of US application number 2003/0218960 (Albrecht). Claim 13 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,507,552 (Gibson) in view of USPN 5,412,597 (Miyazaki). Applicant respectfully traverses these rejections.

As noted herein, Gibson fails to teach or suggest all the elements of the independent claims. Albrecht and Miyazaki fail to cure these deficiencies. For at least the reasons provided with the independent claims, the respective dependent claims are allowable over Gibson in view of Albrecht and Miyazaki.

CONCLUSION

In view of the above, Applicant believes that all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

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